

### **REMARKS**

Claims 31, 32, 35, and 36 are pending in this application.

### **REJECTIONS UNDER § 112**

The Office Action rejects claims 31, 32, 35, and 36 as allegedly being non-compliant with the written description requirement of § 112, first paragraph. The Office Action alleges that the limitation of: “delivering a first electrical stimulus to an intralaminar nuclei of a brain of a mammal in need of treatment of a psychiatric disorder or psychiatric function; and delivering a second electrical stimulus to another area of the brain, wherein the another area of the brain is not the intralaminar nuclei” is not supported by the specification. Applicant respectfully requests reconsideration.

The MPEP § 2163.02 sets out the standard for determining whether there is compliance with the written description requirement as follows: “Whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.”

In this regard, the MPEP § 2163.04(I) instructs as follows: “Upon reply by applicant, before repeating any rejection under 35 U.S.C. 112, para. 1, for lack of written description, review the basis for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant. If the whole record now demonstrates that the written description requirement is satisfied, do not repeat the rejection in the next Office action.”

Accordingly, Applicant submits evidence by way of a Rule 132 Declaration (enclosed herewith) that the specification “conveys with reasonable clarity to those skilled in the art” that the stimulation of the intralaminar nuclei in combination with another site in the brain was intended to be part of Applicant’s invention. As stated in the Rule 132 Declaration, FIG. 2 of the specification (referred to as the “Rezai publication” in the Declaration) shows the various connections/projections that are implicated in the circuitry of psychiatric activity and disorders. FIG. 4 focuses on the bilateral projections between the intralaminar nuclei (ILN) and other parts

of the brain: PFC/OFC (pre-frontal cortex/orbital-frontal cortex), anterior cingulate, basal ganglia, posterior parietal cortex, superior colliculus, substantia nigra, brainstem RAS, and cerebellum.

Furthermore, ¶ [0072] of the specification states: “In addition to being applied to the patient’s intralaminar nuclei or portion thereof, the electrical stimulation can also extend to other regions of the brain.” This statement in the specification, by itself, indicates that stimulation can be applied to both the ILN and another site in the brain. Furthermore, when this statement is considered in view of the specification’s description of the interconnections between the ILN and other brain sites, it further reinforces that stimulation can be applied to both the ILN and another site in the brain.

As instructed by the MPEP § 2163.04(I), “the whole record now demonstrates that the written description requirement is satisfied,” and thus, the Examiner should “not repeat the rejection in the next Office Action.” For at least these reasons, Applicant respectfully submits that the rejected claims are in compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, and request that the rejection be withdrawn.

For the same reasons stated above, Applicant requests withdrawal of the “New Matter” objection as well.

### **REJECTIONS UNDER § 102**

The Office Action rejects claims 31, 32, 35, and 36 under § 102(e) as allegedly being anticipated by *John et al.* (U.S. Patent No. 6,463,328). Applicant requests reconsideration.

Independent claim 31 recites “delivering a first electrical stimulus to an intralaminar nuclei of a brain of a mammal having a psychiatric disorder” and “delivering a second electrical stimulus to another area of the brain, wherein the another area of the brain is not the intralaminar nuclei.” *John* at col. 11, lns. 13-19 describe two separate stimulation sites, but does not indicate that one site is an intralaminar nuclei and the other site is not.

For at least these reasons, Applicant respectfully submits that claim 31, and the claims that depend therefrom, are not anticipated by *John*. Accordingly, withdrawal of the rejection is respectfully requested.

**CONCLUSION**

Applicant respectfully submits that the present application is in condition for allowance. The Examiner is invited to contact Applicant's representative to discuss any issue that would expedite allowance of this application.

The Commissioner is authorized to charge all required fees, fees under § 1.17, or all required extension of time fees, or to credit any overpayment to Deposit Account No. 11-0600 (Kenyon & Kenyon LLP).

Respectfully submitted,

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